

REMARKS

The application has been amended to place it in condition for allowance at the time of the next Official Action.

Claims 1-7 and 10-13 are pending in the application.

Applicants note that claim 13 was not addressed by the present Official Action.

Claim 5 is amended as suggested in the Official Action to address the claim objection.

Claims 1-4 and 12 are amended to provide proper antecedent basis for the elements noted in the Official Action to address the 35 USC 112, second paragraph rejection.

Claims 1, 3 and 4 were rejected under 35 USC 102(e) as being anticipated by TEO et al. 6,540,763. That rejection is respectfully traversed.

Claim 1 is amended to clarify that the webs are of undulating form in a relaxed condition. Support for this feature can be found at least in Figure 3.

TEO discloses a device in which the lancet is subjected to a catapult action by virtue of two members 44 of elastic connected between the operating button and the lancet. In use, the operating button is depressed, thus tensioning the elastic members 44 until such time as a trigger surface 36 on the operating button releases the lancet for forward movement. In this arrangement, we do not think the members 44 can be realistically be said to be of undulating form. It is true that,

when the lancet shoots to its forwardmost position the elastic members 44 are shown (schematically) in Figure 12 as crumpling into zigzag form, but this is only a momentary condition.

Although the characterization of TEO set forth in the Official Action is not a realistic reading of the document (one of ordinary skill in the art would not consider TEO as meeting claim 1), nevertheless, claim 1 is amended to clarify that the webs are of undulating form when in their relaxed condition. TEO does not disclose such a feature and thus, claim 1 and claims 3 and 4 which depend therefrom, are not anticipated by TEO

Claims 1-6, 10 and 12 were rejected under 35 USC 103(a) as being unpatentable over HOFERT et al. 4,203,446 in view of KIRK et al. 4,860,740. That rejection is respectfully traversed.

The Official Action recognizes that HOFERT does not disclose an undulating return spring. KIRK is offered for this feature with the Official Action concluding that it would have been obvious to include an undulating return member instead of the coiled spring of HOFERT.

However, even if one of ordinary skill in the art were to consider the proposed combination of references in the first instance, the invention of claim 1 (and 12) would not obviously result.

HOFERT discloses a recoilless lancet assembly in which a lancet has a body 16 and a tip 12 and a separate return spring 20. The device 20 is fairly conventional, employing a sprung-loaded striker to move sharply forward and impact the lancet to

momentarily project the tip from the body. Return spring 20
returns the tip inside the body (see column 3, lines 19-22).

As set forth on page 1, lines 16-19 of the present application, an object of the present invention is to overcome the shortcomings of the prior art (as embodied in HOFERT) by having integral webs of undulating form.

However, KIRK does not address these shortcomings of HOFERT.

That is, the Federal Circuit has held that "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor, or if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992).

"A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals logically would have commended itself to an inventor's attention in considering his problem." *Wang Laboratories Inc. v. Toshiba Corp.*, 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993).

In the present case, KIRIK is clearly not in the field of lancet devices that use a projecting needle.

Moreover, KIRK is not reasonably pertinent to the present invention because the matter with which it deals logically would not have commended itself to an inventor's

attention in considering the problem of returning a needle tip inside a body (casing).

Rather, KIRK relates to an inhaler device having a radial magazine loaded with two-piece capsules containing inhalant powder. There is a mechanism for removing the outer capsule piece and rotating the magazine to a position where the other capsule piece, which contains inhalant powder, is aligned transversely to an inhalation duct. The removal of the capsule piece and rotation of the magazine is effected using a spring-loaded extractor moulding 23, visible in Figure 1, which includes at its upper end 30 a gripping part 38 for engaging the capsule and, at its lower end, a pawl 41 for rotating the magazine. The extractor is sprung biased upwardly to a raised position (out of the casing body) by two 'undulating, flexible, resilient spring portions 40' (see column 7, lines 8-13).

Thus, in KIRK, the undulating spring portions are used to push the medicament containing capsule out of the body. In view of this, even if one of ordinary skill in the art were to look to KIRK, in the first instance, it would not have been obvious to improve upon a return spring 20 that returns the tip inside the body based on KIRK because KIRK teaches the use of an undulating spring to push a capsule out of the body.

Accordingly, claim 1 and the claims that depend therefrom are believed to be patentable over the proposed combination of references.

Claim 12 includes similar features and the analysis above regarding claim 1 as to these features applies to claim 12.

In addition, claim 12 further requires that the forward free ends of the undulating webs are spaced from the abutment surfaces when the lancet is in its cocked position. This feature emphasizes that the undulating webs are effectively self-supporting and the gap ensures unencumbered movement of the lancet during the initial firing phase.

The Official Action argues that spacing the ends of the webs of KIRK from their corresponding abutments would have been within the 'purview' of one skilled in the art.

However, this position is not supported by the disclosure of KIRK and rather, is contrary thereto.

Indeed, if there were a gap between the ends of the springs 40 and the corresponding abutments in KIRK, the device would not provide the upward bias as required and, more importantly, would not perform the critical function of moving from the position of Figure 3a to Figure 3c to remove the upper capsule piece and to stage the magazine, which is fundamental to its operation.

Claims 7 and 11 were rejected under 35 USC 103(a) as being unpatentable over HOFERT in view of KIRK and further in view of TAVEL 3,375,381. That rejection is respectfully traversed.

TAVEL is only cited with respect to features of dependent claims 7 and 11. TAVEL does not overcome the shortcomings of the HOFERT/KIRK rejection set forth above with respect to claim 1. Since claims 7 and 11 depend from claim 1 and further define the invention, these claims are believed to be patentable at least for depending from an allowable independent claim.

Moreover, TAVEL does not appear to be pertinent to the present invention.

TAVEL is directed to a cordless electric vibrator in which the cap closing the battery compartment is removably secured to the body by a bayonet type arrangement. Such an arrangement in the field of electric vibrators is not only far removed from lancets, but also, is not pertinent to a cap to be removed to expose the tip of the needle.

Accordingly, claim 7 and 11 are believed to be patentable independent of the patentability of the claims on which they depend.

In view of the present amendment and the foregoing Remarks, therefore, it is believed that this application has been placed in condition for allowance, and reconsideration and allowance are respectfully requested.

The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 25-0120 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

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